

REMARKS

In our June 13, 2007 response, applicants pointed out that Claims 1-11, 13-17, 19-26, 28-36 and 38-47 were pending in the present application and that Claims 1-11, 13-16, 20, 31, 32, 36 and 38-40 and 47 had been withdrawn from consideration. However, we noted that in the December 13, 2007 Office Action, the Examiner had apparently and erroneously withdrawn claims 41-46. We noted that Claims 41-46 had been pending and the subject of three prior Office Actions on July 14, 2005, April 5, 2006 and July 13, 2006 as well as argument and amendments to the claims. We stated that it appeared that these claims have been incorrectly withdrawn and not addressed in the current Office Action. Applicant respectfully requested in our June 13, 2007 response that claims 41-46 be further considered and addressed in a new action so that applicant can respond accordingly.

The Examiner responded to our June 13, 2007 request by summarily stating that he now feels that claims 41-46 are directed to non-elected species. Not only is such a determination inappropriate at this stage, it is improper to make a withdrawal of claims final without explanation and without giving the applicants an opportunity to respond. Applicants respectfully request reconsideration of this determination. Applicants believe that the Final rejection should be withdrawn and the rejection be made Non-Final. Alternatively, applicants request an explanation as to why the Examiner now feels, after two years of dealing with the claims that the claims now deal with a non-elected species. Applicants are entitled to respond to new determinations that have not been raised previously. If this was an oversight of the Examiner, then the Applicants should not be penalized and restricted in their ability to address the Examiner's decision.

Finally, the Examiner has stated that applicants have used an inappropriate status identifier pursuant to 37 CFR 1.121(c). For the reasons discussed above, applicants disagree. Either the withdrawal of the claims is based upon Examiner error or the decision was made without explanation thereby depriving the applicants an opportunity to respond accordingly. Regardless, such an assertion is improper and should be withdrawn.

Notwithstanding the above arguments, applicants have changed the identifier to read “withdrawn” but request that this issue be addressed by the Examiner.

Furthermore, the Examiner issued a new ground of rejection that is not based upon applicants’ amendments or the filing of an Information Disclosure Statement. The new ground of rejection is based upon a reference (Wark ‘758) that has not been raised in a rejection until now. Applicants were entitled to respond to the new rejection and making the rejection Final without giving applicants an opportunity to respond was premature.

Applicants filed a Request for Continued Examination in order to preserve the application, which is entirely appropriate whether an Examiner appropriately, or prematurely, as in the present case, made an Office Action final. Filing an RCE to preserve and maintain an application cannot be interpreted as waiving the right to full examination of an application. Thus, the Examiner’s finding that any argument by the applicant (requesting reconsideration of the Examiner’s ruling) is moot by virtue of filing an RCE is incorrect.

In the May 15, 2008 Office Action, the Examiner once again issued a Final Office Action. Applicants have responded appropriately with a Request for Reconsideration in order to preserve the application. Therefore, applicants renew their request for consideration of the Examiner’s determination of finality and hereby request that the prior action be made Non-Final.

The fact remains that the Examiner arbitrarily took away the applicants right to respond to an office action. The Examiner has ignored the applicants request for reconsideration by stating that he eventually gave a reason for restricting the case several years into the prosecution and the issue is now moot. The issue is not whether the new restriction is warranted, the issue is whether the Examiner prematurely made an action final without giving the applicants the chance to respond. When an Examiner prematurely issues a final action, the finality should be withdrawn and the applicants should be given an opportunity to respond. Applicants respectfully request correction of this Examiner error.

Claims 17, 19, 21-26, 28-30 and 33-35 stand rejected.

Rejection under 35 U.S.C. §103 (a)

The Examiner has rejected claims 17, 21-26, 28 and 33-35 under 35 U.S.C. § 103(a) as unpatentable over Oliver, et al. ('116) in view of U.S. Patent 6,279,758 to Wark et al. Applicants respectfully traverse this rejection.

The Examiner correctly points out that Oliver does not teach the presence of asymmetric spacing of positioning features. Oliver '116 does not teach disclose or suggest the present invention and clearly shows symmetric spacing of positioning features because a second positioning feature is directly opposing the first positioning feature. In fact, Oliver '116 actually teaches away from the present invention.

The placement of positioning features is a critical aspect of the present invention. The present invention teaches the precise and unambiguous placement of a positioning feature on one side of a patient support device with a second positioning feature asymmetrically spaced from the first feature such that the area directly opposing the first feature is free of a positioning feature. Each of the rejected claims in this grouping require at least one positioning feature on a first side of the patient support device asymmetrically spaced from at least one positioning feature on a second side.

The present specification clearly defines and spells out the configuration of asymmetric spacing as well as the functionality. For example, on page 8, lines 8-14 applicants teach that asymmetric spacing results in a positioning feature on one side of the device with the directly opposing side area free of a positioning feature. Furthermore, asymmetric spacing enables a more secure attachment of an accessory device adaptor or a more secure attachment of the accessory itself. In addition to the specification, Figure 10 clearly shows the asymmetric spacing of the present invention. (See also, page 3, lines 21-22 and page 5, lines 1-3).

The precise arrangement of positioning features would not have been obvious to one skilled in the art at the time the invention was made. To the contrary, applicant has identified, and the present invention addresses, a problem found in prior patient positioning devices. Applicant solves the above problem and provides the unexpected result of making the positioning and repositioning of patients and accessories on a table more accurate and reproducible. Furthermore, not only has no one presented the present unique solution to the problem but such a solution has never been contemplated until the present invention.

The Examiner attempts to correct the critical deficiencies in Oliver by citing Wark '758. Oliver '116 teaches away from the present invention, as the Examiner recognizes, because it does not teach the critical aspect of the invention. The present invention provides a unique solution in patient positioning by the placement of asymmetric spacing. Oliver does not teach, disclose or suggest asymmetric spacing. Oliver teaches **symmetric** spacing at best and in other words, the complete **opposite** of the present spacing solution. By not teaching the present invention but instead teaching the **opposite** solution, Oliver teaches away from the present invention. It is inappropriate to rely upon a reference that teaches the **opposite** of the critical feature of the present invention. The Examiner states that he cannot understand how Oliver teaches away from the present invention. To support this conclusion, the Examiner states that Oliver provides for an indexing means to allow positioning of an accessory device. Unfortunately, the Examiner fails to focus on the actual invention and the critical, required limitation of the present invention. Nor does the Examiner recognize what has been argued consistently for more than two years. Applicants request that the Examiner reconsider his interpretation of Oliver and recognize that it simply does not teach the asymmetric spacing of the present invention but teaches the opposite of the present invention.

Furthermore, Wark '758 is an inappropriate reference and covers non-analogous art. Wark '758 is directed to an apparatus and method for facilitating circuit board processing. A circuit board is not a patient support. Thus, the Examiner's statement that column 4, lines 63-67 teaches providing an indexing position means along one or both side edges of a patient

support device is clearly in error. Wark has nothing to do with the present invention or a patient support device and the applicants respectfully request that the rejection be withdrawn.

In response to Applicants arguments, the Examiner now refers to Wark as teaching a planar support member and makes the assessment that this is the equivalent as a patient support device. Such a conclusion across non-analogous art is incorrect. In using hindsight reasoning, which is improper, the Examiner claims that one skilled in the art would have created the present invention. However, such reasoning fails the reality test as asymmetric spacing has never been done in the art of patient support devices prior to the present invention. The surprising accuracy and repeatable positioning of a patient using the device of the present invention further supports the novelty and non-obviousness of the present invention.

Furthermore, the Examiner attempts to discard the critical aspect of the present invention and in so doing relies upon Ex Parte Wu for the general proposition that an omission of an element and its function is obvious if the function is not desired. This characterization is not appropriate in the instant invention and over simplifies the application of Wu. Precise asymmetric placement of positioning features is an essential part of the present invention. Applicant does not claim an improvement by eliminating an element from prior art. Nor does applicant simply eliminate an element (a positioning feature) as the Examiner suggests. Thus, the Examiner's reliance on Wu is misplaced and the rejection should be withdrawn.

The Examiner has also rejected claims 17, 19, 21-26, 28-30 and 33-35 under 35 U.S.C. §103(a) as being unpatentable over WIPO Publication WO 01/35828 (WIPO'828) in view of Oliver, et al. ('116) and in view of Wark '758. Applicant further traverses this rejection.

As discussed above, applicants teach that asymmetric spacing results in a positioning feature on one side of the device with the directly opposing side area free of a positioning feature. As discussed above, Oliver '116 therefore fails as a primary reference. WIPO '828 cannot cure the deficiencies in Oliver. WIPO '828 does not teach positioning features at all but teaches a patient support surface 10 connected to the head 12 of a support column 14. The support surface 10 consists of a table plate 16 and a guide unit 18, which

includes an upper guide housing 20 and a lower guide housing 22. The table plate 16 is slidably guided in the upper guide housing 20 in its longitudinal direction. Not only does WIPO '828 fail to teach positioning features but it fails to teach asymmetric spacing that includes a positioning feature on one side of the device with the directly opposing side area free of a positioning feature, as disclosed and claimed in the present invention.

Finally, not only does Olivier '116 teach away from the present invention, Wark '758 is an inappropriate reference and covers non-analogous art. Wark '758 is directed to an apparatus and method for facilitating circuit board processing. Thus, the Examiner's statement that column 4, lines 63-67 teaches providing an indexing position means along one or both side edges of a patient support device is clearly in error. Wark has nothing to do with the present invention and as every claim rejected in the present invention requires asymmetric spacing of positioning features, the rejection should be withdrawn.

Conclusion

Based on the Remarks above, Applicant respectfully requests the allowance of all pending claims or allowance of all pending claims.

Respectfully submitted,
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